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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,998	06/23/2003	Thomas M. Brennan	28690-705.302	1644
7590 02/12/2007 Albert P. Halluin Wilson Sonsini Goodrich & Rosati 650 Page Mill Road Palo Alto, CA 94304			EXAMINER BABIC, CHRISTOPHER M	
			ART UNIT	PAPER NUMBER
			1637	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/12/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/602,998

Applicant(s)

BRENNAN ET AL.

Examiner

Christopher M. Babic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on April 24, 2006 has been entered. Claim(s) 2, 4-13, and 15 are pending.

Claim Interpretation

With regard to the claimed system, it is initially noted that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the *intended use* of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone (see *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the phrase --for amplifying a plurality of target nucleic acids-- is considered an intended use of the claimed structure, and does not incorporate a patentably distinguishable feature.

Furthermore, a similar reasoning applies to the recitation of --releasable forward and reverse primers-- and --releasable sequences complementary to forward and reverse primers--.

First, with regard to the phrases --forward and reverse primers--, they recite *intended uses* of oligonucleotides, i.e. any oligonucleotide capable of hybridization to a complement and extension by an appropriate polymerase can be considered a forward or reverse primer.

Second, with regard to the term --releasable--, absent any formal structural definition within the specification, the term is given its broadest reasonable interpretation. Thus, any oligonucleotide capable of being released from a solid support (e.g. through nuclease digestion) can be considered to be releasable.

Lastly, the phrase --adapted to be released before an amplification reaction-- is not considered to further limit the claimed invention because any oligonucleotide capable of being released is necessarily adapted to be released at anytime during any process.

Claim Rejections - 35 USC § 102

Upon further consideration, a new ground(s) of rejection is made in view of previously discovered prior art.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim(s) 1, 4-6, 8, and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Rava et al. (U.S. 5,545,531).

With regard to claim(s) 1, Rava discloses a system (fig. 3-7; col. 7, line 55-col. 11, line 40, for example) comprising: (a) a first solid support wherein (1) the surface of said first solid support comprises a plurality of derivatized areas (fig. 4; col. 8, lines 1-20, biological chip wafer, for example); (2) at least one releasable forward primer and at least one releasable reverse primer for each target nucleic acid or at least one releasable sequence complementary to said forward and said reverse primers are immobilized on a derivatized area of the first solid support (col. 3, lines 35-50; col. 9, lines 10-25, oligonucleotide probes, for example), wherein said releasable primers or releasable sequences are adapted to be released before an amplification reaction (col. 3, lines 35-50; col. 9, lines 10-25, inherently releasable by nuclease, for example); and (b) a second solid support wherein said second solid support comprises a plurality of wells and each well corresponds to at least one forward and at least one reverse primer for each target nucleic acid (fig. 4; col. 8, lines 1-20, biological chip plate wells, for example).

It is submitted that the above rejection is based on the claim interpretation discussed above. First, the oligonucleotide probes taught by Rava are capable of

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hybridization to a complement and extension by an appropriate polymerase, and thus, are considered forward and reverse primers. Second, the oligonucleotide probes taught by Rava are capable of being released from the biological chip solid support (e.g. through nuclease digestion), and thus, are considered forward and reverse primers. Lastly, since the oligonucleotide probes taught by Rava are capable of being released from the biological chip solid support, they are necessarily adapted to be released at anytime during any process.

Therefore the entire structure of Rava is capable of performing the intended use of the claimed invention, and thus, is anticipated by the applied teachings.

With regard to claim(s) 4, the oligonucleotide probes taught by Rava (col. 3, lines 35-50; col. 9, lines 10-25, oligonucleotide probes, for example) are necessarily subsequences of a larger polynucleotide.

With regard to claim(s) 5, Rava discloses substrates made of glass (col. 9, lines 25-55, for example).

With regard to claim(s) 6 and 8, Rava discloses covalent immobilization of oligonucleotides through various functionalities such as Si-OH (fig. 8; col. 9, lines 25-65, for example). As noted above, the oligonucleotide probes taught by Rava are capable of being released from the biological chip solid support (e.g. through nuclease digestion).

With regard to claim(s) 10, Rava discloses solid support surfaces with Si-OH functionalities; therefore Rava et al. teach hydrophilic areas (col. 9, lines 50-52, for example).

With regard to claim(s) 11, Rava discloses an example with a feature size of about 100 microns on a side which would give an array with 10,000 probe addresses per 1 cm^2 ; therefore Rava et al. anticipate a density of derivatized areas of 10 to 10,000 per cm^2 (col. 10, lines 38-40, for example).

With regard to claim(s) 12, Rava discloses a probe array size of 0.25 mm^2 ; therefore Rava et al. anticipate the size of a derivatized area on a solid support that is between 10^{-3} to 5 mm^2 (col. 9, lines 21-24, for example).

With regard to claim(s) 13, Rava discloses a probe array with 105 features; therefore Rava et al. anticipate a number of derivatized areas on a solid support between 10 to 500,000 (col. 9, lines 21-24, for example).

2. Claim(s) 1, 4-6, 8-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Dower et al. (U.S. 5,639,603).

With regard to claim(s) 1, Dower discloses a system (fig. 1; col. 43, line 30-col. 44, line 50, for example) comprising: (a) a first solid support (fig. 1; col. 43, lines 40-50, reaction plate, for example) wherein (1) the surface of said first solid support comprises a plurality of derivatized areas (fig. 1; col. 43, lines 40-50, reaction sites w/ beads, for example); (2) at least one releasable forward primer and at least one releasable reverse primer for each target nucleic acid or at least one releasable sequence complementary to said forward and said reverse primers are immobilized on a derivatized area of the first solid support (col. 7, line 60-col. 8, line 15; col. 30, lines 10-35; col. 42, lines 40-60,

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oligonucleotide synthesis, for example), wherein said releasable primers or releasable sequences are adapted to be released before an amplification reaction (col. 13, lines 10-35, cleavable linkers, for example); and (b) a second solid support wherein said second solid support comprises a plurality of wells and each well corresponds to at least one forward and at least one reverse primer for each target nucleic acid (fig. 1; col. 43, lines 55-65, reaction chambers, for example).

It is submitted that the above rejection is based on the claim interpretation discussed above. First, the oligonucleotides taught by Dower are capable of hybridization to a complement and extension by an appropriate polymerase, and thus, are considered forward and reverse primers. Second, the oligonucleotide probes taught by Dower are capable of being released from the biological chip solid support (e.g. through nuclease digestion), and thus, are considered forward and reverse primers. Lastly, since the oligonucleotide probes taught by Dower are capable of being released from the biological chip solid support, they are necessarily adapted to be released at anytime during any process.

Therefore the entire structure of Dower is capable of performing the intended use of the claimed invention, and thus, is anticipated by the applied teachings.

With regard to claim(s) 4, the oligonucleotide probes taught by Dower (col. 7, line 60-col. 8, line 15; col. 30, lines 10-35; col. 42, lines 40-60, oligonucleotide synthesis, for example) are necessarily subsequences of a larger polynucleotide.

With regard to claim(s) 5, Dower discloses substrates made of glass (col. 11, lines 30-40, for example).

With regard to claim(s) 6, 8, 9 and 15, Dower discloses covalent immobilization of oligonucleotides through various linkers such as photocleavable functionalities (col. 13, lines 20-35, for example).

With regard to claim(s) 10, Dower discloses solid support surfaces with hydrophilic functionalities (col. 13, lines 10-20, for example).

With regard to claim(s) 13, Dower discloses an array with 256 reaction sites; therefore Rava et al. anticipate a number of derivatized areas on a solid support between 10 to 500,000 (col. 43, lines 40-55, for example).

Claim Rejections - 35 USC § 103

The rejection of claim(s) 2-13 and 15 over Rava in view of Monforte have been withdrawn in view of the new grounds of rejection presented above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim(s) 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rava as applied to claim(s) 1, 4-6, 8, and 10-13 above or Dower et al. (U.S. 5,639,603) as applied to claim(s) 1, 4-6, 8-10, 13, and 15 above, and further in view of Monforte (U.S. 5,700,642).

With regard to claim(s) 7, the methods of the previously applied reference(s) have been outlined in the above rejections. The previously applied reference(s) do not expressly teach non-covalent immobilization of oligonucleotides or the use of photocleavable linkages.

It is initially submitted that the attachment of oligonucleotides to solid supports through non-covalent bonds as well as photocleavable linkers was well-known practice within the art.

Monforte provides a supporting disclosure that teaches the attachment of oligonucleotides to solid supports through non-covalent bonds (col. 19, line 60-col. 20, line10). They further teach that non-covalent immobilization is preferred in some instances because the immobilized complex is resistant to extreme reaction conditions (e.g. pH, solvents, etc).

Thus, it would have been *prima facie obvious* to a practitioner of ordinary skill in the art at the time of invention to attach oligonucleotides to the solid supports of Rava through non-covalent bonds since Monforte suggests such a modification to enhance the resistant to extreme reaction conditions (e.g. pH, solvents, etc) of the immobilized complex is, thus arriving at the claimed invention.

Conclusion

Claims 2, 4-13, and 15 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Babic whose telephone number is 571-272-8507. The examiner can normally be reached on Monday-Friday 7:00AM to 4:00PM.

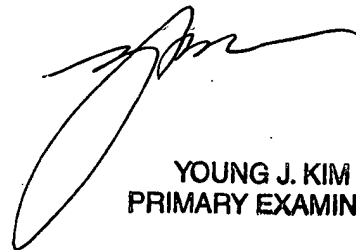
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 2/1/07

Christopher M. Babic
Patent Examiner
AU 1637



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PRIMARY EXAMINER